

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/528,118
Applicants : Norbert HOLL
Filed : February 3, 2006
TC/A.U. : 2624
Examiner : Nancy BITAR
Title : Method and Checking Device for
Checking Documents of Value
Docket No. : 2732-167
Customer No. : 6449
Confirmation No. : 8956

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant hereby requests a pre-appeal brief review of the non-final rejections to the claims in the above-identified application. This Request is being submitted in response to the Office Action mailed June 28, 2010. The reasons for the request are set forth in the attached Set of Arguments for Which Review Has Been Requested.

Applicant submits herewith a Notice of Appeal and Petition for Extension of Time, together with the required fees. In the event that any additional fees are required, such fees may be charged to Counsel's Deposit Account No. 02-2135.

Respectfully submitted,

Date: October 28, 2010

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SET OF ARGUMENTS FOR WHICH REVIEW HAS BEEN REQUESTED

Applicant appeals from the rejections of claims 1-23. See Office Action dated June 28, 2010 (“Office Action”). Particularly, independent claims 1 and 13 and dependent claims 2-12 and 14-23 stand rejected as allegedly obvious under 35 U.S.C. § 103(a) in view of the combination of U.S. Patent No. 6,101,266 to Laskowski et al. (“Laskowski”) and U.S. Patent Publication No. 2007/0095630 to Mennie et al. (“Mennie”). See Office Action at pages 3-8.

Pre-appeal brief review is appropriate in this case because the Examiner made clear errors when evaluating the claims of the application and the disclosures of the relied upon prior art references, Laskowski and Mennie. The Applicant’s reasons for review are not premised in mere interpretations of the claims or prior art, but instead are grounded in law and fact.

Review is specifically sought for the following reasons:

- the Examiner has failed to address Applicant’s previously raised argument that Laskowski teaches away from the claimed invention; and
- the combination of Laskowski and Mennie, contrary to the Examiner’s assertion, clearly fails to teach or suggest summing (or an evaluation unit provided to sum) the transmitted and reflected light to obtain a sum intensity value, an element of each claim.

As a result of the above-identified errors, the Examiner’s rejections should be withdrawn and claims 1-23 should be allowed. Detailed reasons for the withdrawal of the Examiner’s rejections are set forth in the Reply To Office Action filed March 30, 2010 (“Reply”). Additionally, further details are provided below along with specific citations to the record.

The Examiner’s rejection of claims 1-23 as obvious over Laskowski in view of Mennie is improper because Laskowski teaches away from the claimed invention.

Claims 1-23 were rejected as obvious over Laskowski in view of Mennie. See Office Action at pages 3-8. Claims 1 and 13 are the independent claims pending in the application. Laskowski clearly teaches away from the claimed limitations of:

- for each measuring place the intensities of the transmitted and the reflected light are summed up to obtain a sum intensity value, as recited in claim 1; and
- an evaluation unit is provided, in which the intensities of the transmitted and reflected light are summed up for each measuring place, as recited in claim 13. (emphasis added.)

This argument was raised previously, but not addressed by the Examiner. The argument was presented in the Reply at pages 5-6 and in Applicant's Appeal Brief dated September 18, 2009 at page 7, to which no examiner's answer was submitted. The Examiner has failed to consider all rebuttal arguments and evidence presented by Applicant, as required under MPEP § 2145. Specifically, the Examiner has not responded to the Applicant's arguments that "[i]t is improper to combine references where the references teach away from their combination." See MPEP § 2145 (citing In re Grasselli, 713 F.2d 731, 743 (Fed. Cir. 1983)).

The Examiner has instead opted to maintain the rejection based on the flawed primary reference Laskowski and a series of different secondary references. See Office Action at page 3 (citing Mennie as the secondary reference); Office Action dated December 30, 2009 at page 3 (citing Philipp et al. as the secondary reference). The Examiner has continuously and improperly ignored the identified deficiencies of Laskowski. Applicant now presents, for the third time, why the Examiner's rejection is legally unsustainable and must be withdrawn.

Laskowski is generally directed to an apparatus and method of determining the conditions and/or values of bank notes. See Laskowski Abstract. More specifically, Laskowski discloses determining the condition and/or value of a bank note based on measurements of intensities of light that are either reflected off or transmitted through a bank note. See Laskowski col. 3, ln. 66 - col. 4, ln. 9. The measurement of light reflected off a bank note is referred to as a reflectance value. Id. The measurement of light transmitted through a bank note is referred to as a transmission value. Id. These measurements are used to create a correlation between the sensed value set and a stored value set. See Laskowski col. 4, lns. 18-39. Based on the level of correlation, the denomination and orientation of the observed bank note can be identified. See Laskowski col. 4, lns. 29-39.

Laskowski specifically addresses the detection of soiling and/or spots on a bank note at col. 9, lns. 49-58. In this section Laskowski states:

Calculating the transmission and reflectance values separately has the advantage that the individual values can be analyzed individually by the control circuit in accordance with its programming. This may be preferred in some embodiments. For example, high correlation for overall reflectance but not transmission may be indicative of some quality or condition of the note that may warrant taking it out of circulation. This may include for example that the note is worn or soiled, or that it is a double note in which two genuine notes are moving in overlapped relation.

See Laskowski col. 9, lns. 49-58 (emphasis added.) That is, Laskowski expressly states that it is advantageous and preferred for the reflectance and transmission values to be analyzed individually and not as a summed value when assessing the level of soiling and spots in a bank note. Thus, Laskowski, in the context of determining soiling and spots in a document of value, clearly teaches away from summing up for each measuring place, the intensities of the transmitted and the reflected light to obtain a sum intensity value, as recited in claim 1, and an evaluation unit in which the intensities of the transmitted and reflected light are summed up for each measuring place, as recited in claim 13.

Even assuming, arguendo, that the combination of Mennie and Laskowski does teach or suggest each and every limitation of the claimed invention, the combination of Laskowski with **any secondary reference** to form a rejection under 35 U.S.C. § 103 is improper because it is improper to combine references where one of the references teach away from their combination. See MPEP § 2145; In re Grasselli, 713 F.2d at 743 (emphasis added.) For at least the above discussed reasons, the Examiner's rejection of claims 1 and 13 is legally improper and should be withdrawn. Likewise, the Examiner's rejection of claims 2-12 and 14-23, which depend from claims 1 and 13, is also legally improper and should be withdrawn.

The Examiner's rejection of claims 1-23 as obvious over Laskowski in view of Mennie is improper because the combination fails to teach or suggest each and every limitation of the claimed invention.

As described above, the Examiner's addition of Mennie to the rejection fails to render the claimed invention obvious because the addition of Mennie in no way cures or alters away the fact that Laskowski teaches away from the claimed invention. For at least this reason, claim 23 is patentable over the combination of Mennie and Laskowski.

Additionally, even if the combination is proper, which it is not, the combination of Laskowski and Mennie fails to teach or suggest each and every limitation of independent claims 1 and 13. For this independent and separate use, claims 1-23 are patentable over the combination of Mennie and Laskowski. The Examiner admits that "Laskowski et al [sic] fails to teach the reflected light are [sic] summed up to obtain a sum intensity value and the sum intensity value of each measuring place is each compared to a predetermined value."¹ See Office Action at page 4

¹ This admission misstates the limitations recited in claims 1 and 13. Specifically, the claims require that "for each measuring place the intensities of the transmitted and the reflected light are summed up to obtain a sum intensity value," as recited in claim 1, and "an evaluation unit is

(emphasis added.) The Examiner instead asserts that these limitations are taught by Mennie. The Examiner is wrong.

Mennie is generally directed to a currency evaluation device for receiving a currency bill, including a magnetic attribute, and evaluating the currency bill. See Mennie Abstract. More specifically, Mennie discloses determining the currency and denomination of a bill by comparing a checksum value to a master value. See Mennie, inter alia, paras. [0045]-[0046], [0062], and [0066]-[0067]. The checksum value of Mennie is derived from information collected using optical and/or magnetic scanheads. See Mennie paras. [0035]. The information collected by the scanheads “can include reflected light properties such as reflected light intensity characteristics, light transmissivity properties, various magnetic properties of a bill, the presence of a security thread embedded within a bill, the color of a bill, the thickness or other dimension of a bill, etc.” Mennie para. [0080] (emphasis added.)

Mennie fails to disclose the detection of transmitted light, let alone the summing of transmitted and reflected light. As stated above, Mennie can collect information related to various reflected light properties. See Mennie para. [0080]. The Examiner, perhaps recognizing this deficiency, makes the conclusory statement that “[a]n optical sensor necessarily detects transmitted light.” Office Action at page 5. This statement is unsupported and ignores the descriptions of transmitted light in the specification of the current application. Specifically, transmitted light is not any light transmitted by a radiation source, but rather light that is transmitted through a bank note. See Application paras. [0003], [0031], and [0042]. It is clear that the Examiner has impermissibly stretched the teachings of Mennie to cover the claimed invention.

For at least the above discussed additional reasons, the Examiner’s rejection of claims 1 and 13 is legally improper and should be withdrawn. Likewise, the Examiner’s rejection of claims 2-12 and 14-23, which depend from claims 1 and 13, is also legally improper and should be withdrawn.

provided, in which the intensities of the transmitted and reflected light are summed up for each measuring place,” as recited in claim 13. (emphasis added.)

Conclusion

For the foregoing reasons, pre-appeal brief review is appropriate and the Examiner's rejection, from which appeal has been made, should be immediately withdrawn because of the clear errors discussed above. There simply is no evidence in the record to support the rejections. Further, the rejections run afoul of both the MPEP and long-standing legal precedent. Accordingly, this application should not proceed to appeal and claims 1-23 should be allowed.